



#20/Election
500.36904X00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): MIURA, et al.

Serial No.: 09/254,939

Filed: March 17, 1999

For: METHOD OF FABRICATING SEMICONDUCTOR
DEVICE HAVING TRENCH ELEMENT SEPARATION
STRUCTURE

Group: 2814

Examiner: A. Mai

5/15/02
J. Smith

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RESPONSE

Assistant Commissioner for Patents
Washington, D.C. 20231

May 10, 2002

Sir:

In response to the Office Action mailed March 11, 2002, Applicants
respectfully elect the Species of the third embodiment as shown in Figs. 6A-6N.

It is respectfully submitted that, of the claims presently in the application, claims
1-6, 9, 10, 12, 13, 15 and 18-48 read on the elected Species.

Applicants respectfully traverse the conclusion by the Examiner that there
is currently no generic claim in the application. That is, it is respectfully
submitted that, for example, claim 1, as well as various others of the independent
claims, e.g., claims 2, 4, 5, 9, 10, 15, 41, 43, 45, 46 and 47 are generic claims,

reading on Species 1-4 (which are the first through fourth embodiments), shown respectively in Figs. 2A-2N, Figs. 4A-4N, Figs. 6A-6N and Figs. 8A-8N, of the disclosure of the above-identified application. That is, for example, claim 1 recites a semiconductor device fabrication method including steps of forming an oxidation prevention film and forming a trench, and oxidizing a trench portion formed in the semiconductor substrate, exposed in the trench; burying an insulation film in the oxidized trench and thereafter oxidizing only a portion of the substrate at the upper end of the trench; removing the buried insulating film; and eliminating the oxidation prevention film and thereafter forming a gate oxide film. It is respectfully submitted that these steps are set forth in each of the first through fourth embodiments, as can be seen, for example, in Figs. 3, 5, 7 and 9 of Applicants' original disclosure.

Moreover, Applicants respectfully traverse the restriction requirement set forth in the Office Action mailed March 11, 2002. In connection therewith, Applicants respectfully direct attention to 37 CFR 1.146 (entitled Election of species), stating in pertinent part:

In the first action on an application containing a generic claim to a generic invention (genus) and claims to more than one patentably distinct species embraced thereby, the examiner may require the applicant in the reply to that action to elect a species of his or her invention to which his or her claim will be restricted if no claim to the genus is found to be allowable. [Emphasis added.]

Assuming, arguendo, that the Examiner is correct in his allegations concerning Embodiments 1-4, it is respectfully submitted that the Office Action mailed March 11, 2002 is not "a first action" on the above-identified application containing a generic claim to a generic invention and claims to more than one patentably distinct species embraced thereby; for this reason alone, it is respectfully submitted that the election-of-species requirement is clearly improper.

In any event, and in order to provide a complete response to the Office Action mailed March 11, 2002, as set forth by the Examiner in Item 2 on page 2 of the Office Action mailed March 11, 2002, Applicants respectfully elect the Species of the third embodiment as shown in Figs. 6A-6N, and respectfully submit that claims 1-6, 9, 10, 12, 13, 15 and 18-48 read thereon. Accordingly, consideration of the claims reading on the elected species, in due course, is respectfully requested.

In addition, upon allowance of one of the generic claims, allowance of claims reading on the elected and non-elected species, in the present application, is respectfully requested.

To the extent necessary, Applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the

filing of this paper, including extension of time fees, to Deposit Account No. 01-2135 (Case No. 500.36904X00) and please credit any excess fees to such deposit account.

Respectfully submitted,

ANTONELLI, TERRY, STOUT & KRAUS, LLP

A handwritten signature in black ink, appearing to read "William I. Solomon", is written over a horizontal line.

William I. Solomon
Registration No. 28,565

WIS/slk